

App. No. 10/037,966

Request for continued examination under 37 CFR §1.114
Amendment under 37 CFR §1.111**REMARKS**

Claims 1-4, 12-27, and 47-59 remain pending and under consideration. Claims 1, 12, 16-20, and 23 are independent claims. Claims 5-11, 28-46, and 60-74 drawn to non-elected species are currently withdrawn from consideration. Claims 5-7, 9-11, 28, 35, 39-41, 60-66, and 72-74 are independent Claims. Claims 1, 4, 5-7, 9-13, 16-20, 23, 28, 35, 39-41, 60-66, and 72-74 have been amended. Claims 75-139 drawn to non-elected inventions were previously cancelled. Reexamination and reconsideration of the application, as amended, are hereby respectfully requested.

Applicants acknowledge allowance of Claims 1-4, 12-27, and 47-59 in the Office Action dated 06/21/2004. In a case recently decided by the United States Court of Appeals for the Federal Circuit (CAFC), however, certain language in one of the patents at issue, similar to language originally employed in some of the claims of the instant application, has been construed in a manner differing from that intended by the Applicants. It is not clear whether the CAFC claim construction is specific to the fact patterns of the decided case, or may be applied more generally. Accordingly, the claims in question have been amended so as to ensure that the claims will be construed in the manner originally intended by the Applicants.

The recently-decide case is *Superguide Corporation v. Directv, Inc.* (CAFC 02-1561, -1562, and -1594, decided 02/12/2004). At least within the context of *Superguide*, the Court has interpreted "at least one of" followed by a conjunctive list of items in the patent in suit (US 5038211) to mean at least one of *each* item in the list. In the instant application, the Applicants intended "at least one of" followed by such a list to mean at least one item *from* the list. It is presumed that this was the interpretation of the Examiner as well. Since the claim construction of the CAFC in *Superguide* may at least raise the possibility of a narrower claim construction than that intended by the Applicants, Claims 1, 4, 5-7, 9-13, 16-20, 23, 28, 35, 39-41, 60-66, and 72-74 have been amended. In each instance, the phrase "at least one of" has been deleted, and the conjunction "and" in the subsequent pair or list of items has been replaced by the conjunction "or". In the amended claims, the conjunction "or" is to be construed inclusively (e.g., "a dog or a cat" would be interpreted as "a dog, or a cat, or both"; Bryan A. Garner, Elements of Legal Style p. 103, 2nd ed. 2002), unless: i) it is

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explicitly stated otherwise, e.g., by use of "either-or", "only one of", or similar language; or ii) two or more of the listed alternatives are mutually exclusive within the context of the claim, in which case "or" would encompass only those combinations involving non-mutually-exclusive alternatives. Applicants believe that this amendment does not change the scope of the amended claims from the originally intended scope. In particular, the amendments set forth herein are not narrowing amendments.

In the Office Action of 06/21/2004, the Examiner has stated that generic Claims 1 and 23 have been allowed, and that withdrawn species claims 5-11, 28-46, and 60-74 will be reinstated and allowed upon satisfactory explanation of how each of the withdrawn claims includes all the limitations of an allowed generic claim. Each of Claims 5-11, 28-46, and 60-74 includes all of the limitations of generic Claim 1 or 23, as explained hereinbelow.

The language of Claim 1 is duplicated in each of independent Claims 5-7 and 9-11, each of which includes at least one additional element or limitation. Without altering its contents, each of Claims 5-7 and 9-11 could be rewritten in dependent form as dependent on generic Claim 1. Claim 8 is dependent on Claim 7. Therefore, each of Claims 5-11 includes all of the elements and limitations of generic Claim 1.

The language of Claim 23 is duplicated in each of independent Claims 28, 35, and 39-40, each of which includes at least one additional element or limitation. Without altering its contents, each of Claims 28, 35, and 39-40 could be rewritten in dependent form as dependent on generic Claim 23. Claims 29-34 are dependent on Claim 28. Claims 36-38 are dependent on Claim 35. Therefore, each of Claims 28-40 includes all of the elements and limitations of generic Claim 23.

The language of Claim 1 is duplicated in independent Claim 41, which includes at least one additional element or limitation. Without altering its contents, Claim 41 could be rewritten in dependent form as dependent on generic Claim 1. Claims 42-46 are dependent on Claim 41. Therefore, each of Claims 41-46 includes all of the elements and limitations of generic Claim 1.

The language of Claim 1 is duplicated in each of independent Claims 60-66 and 72-74, each of which includes at least one additional element or limitation. Without

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altering its contents, each of Claims 60-66 and 72-74 could be rewritten in dependent form as dependent on generic Claim 1. Claims 67-71 are dependent on Claim 66. Therefore, each of Claims 60-74 includes all of the elements and limitations of generic Claim 1.

In view of the above, it is submitted that Claims 1-4, 12-27, and 47-59 are still in condition for allowance, and that Claims 5-11, 28-46, and 60-74 are now in condition for allowance. Allowance of Claims 1-4, 23-27, and 47-59 at an early date, and reinstatement and allowance of non-elected species Claims 5-11, 28-46, and 60-74, are earnestly solicited.

Respectfully submitted,



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